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EXAMINER

FISHER, MICHAEL J

ART UNIT	PAPER NUMBER
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3629

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 26

Application Number: 09/503,240
Filing Date: February 14, 2000
Appellant(s): KIM ET AL.

MAILED

AUG 10 2004

Robert E. Bushnell
For Appellant

GROUP 3600

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/8/03.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: There is no rejection that asserts that Claims 1,13,16 and 21 violate public policy.

(7) *Grouping of Claims*

Appellant's brief includes a statement that Apparatus claims 1-12,16-20 and Apparatus claims 13-15 and Method claims 21-25 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,233,026	Kim et al.	5/2001
5,863,106	Beak	1/1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1,13,16 and 21 are rejected under 35 U.S.C. 103. This rejection is set forth in prior Office Action, Paper No. 21 and further, claims 1,13,16 and 21 are rejected under the judicially created doctrine of obviousness-type double patenting.

(11) Response to Argument

The following are in response to the arguments in relation to the rejection under the judicially created doctrine of obviousness-type double patenting.

The appellant's representative argues that the examiner must focus on what the claim language defines and not what it discloses, the examiner has focused on what the claim language discloses as well as that which it defines.

As to appellant's representative's arguments that the lower shield changes the invention, as can be seen in the figures and previously discussed in earlier office actions, the lower shield is not necessary to the workings of the prior art and, as is well settled in case law (see *In re Karlson*, 136 USPQ 184,186; 311 F2d 581 (CCPA 1963)) this is well within the ability of one of ordinary skill in the art. The examiner disagrees

that he is using his own knowledge instead of using the reference. The examiner asserts that he is using the references cited and proper case law (In re Karlson et al.). The examiner further asserts that to have a rear case is very well known, indeed, Kim et al. show a rear case in the figures but the claims are directed toward different connections and therefore, it is not necessary to claim the rear case.

As to the argument that the examiner did not show a motivation to modify the patent into a monitor without a shield, case law shows that this is well within the ability of one of ordinary skill in the art, (see In re Karlson, 136 USPQ 184,186; 311 F2d 581 (CCPA 1963)). As to arguments that the references do not suggest all the claimed limitations, as is discussed in previous office actions, the examiner has endeavored to show that the prior art discloses the invention.

As to arguments that the reference was misapplied in relation to the method claims of 21-25, it would appear to the examiner that having disclosed the apparatus, (that is similarly claimed in the method claims of 21-25) the method would be inherently disclosed. For example, while the prior art does not disclose actually "forming a front casing", the prior art has a front casing and this must be produced in some manner, such production would inherently be 'forming'.

As to arguments that claims 1,13,16 and 21 do not violate public policy, the examiner did not assert that they did violate public policy.

The following are in response to the arguments as to the rejection under 35 U.S.C. 103.

The pins as discussed would function as those claimed in the instant application.

As to arguments that shifting the parts would affect the operation of the apparatus. The examiner agrees that any shifting of any part would, of necessity, affect the operation of any apparatus in some manner. However, the prior case law shows that such a shifting of parts is a matter of obvious design choice. Further, the referenced shifting would not materially affect the operation of the prior art apparatus.

As is discussed above, it would appear to the examiner that having disclosed the apparatus, (that is similarly claimed in the method claims of 21-25) the method would be inherently disclosed. For example, while the prior art does not disclose actually "forming a front casing", the prior art has a front casing and this must be produced in some manner, such production would inherently be 'forming'.

As to arguments regarding the level of ordinary skill in the art, In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

For the above reasons, it is believed that the rejections should be sustained.

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Art Unit: 3629

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Respectfully submitted,

MF 

August 2, 2004

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